

REMARKS

Claims 40 and 41 are pending in the Application and are now presented for examination. Claims 40 and 41 have been amended. No new matter has been added. Claims 44, 46-50 have been cancelled, without prejudice and without disclaimer of subject matter.

Claims 40 and 41 are independent.

35 U.S.C. §112 Rejections

On page 3 of the Office Action, Claims 40, 44 and 46 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Applicant respectfully traverses.

As an initial matter, Claims 44 and 46 have been cancelled, rendering the rejections to these claims moot. The Office Action states that the Specification discloses no algorithm for registering a pseudo name. However, the Specification states that a computer program product running on a computer is used for registering a pseudo name ¶[0025].

[0025] Viewed from a fourth aspect the present invention provides a computer program product directly loadable into the internal memory of a digital computer, comprising software code portions for performing the steps of any one of claim 1 to claim 20 when said product is run on a computer.

Moreover, the Specification describes the algorithm for registering a pseudo name, by first having a user enter a pseudo name, verifying that no other user has registered that particular pseudo name, and then configuring one or more sub profiles. The Specification recites at paragraphs [0042] and [0047]:

[0042] Referring to FIG. 1, at step 100 a user of the postal service (a user is defined as a person, a business or other legal entity) registers a pseudo name for example, 'tracom' and providing no other user has registered the pseudo name

`tracom`, the user creates their individual profile and configures one or more sub profiles for example, a naming profile and a franking profile to define one or more mail services at step 110.

[0047] Once the user has completed steps 100 to 110, the registered pseudo name is displayed (by means of writing, printing or other scribing means) on the mail object at step 120 and sent to the post office or delivery service through the normal delivery channels.

Applicant respectfully asserts that amended Claim 40 is not indefinite, believes that the rejection has been addressed and respectfully requests the withdrawal of these rejections.

35 U.S.C. §103 Rejections

On page 4 of the Office Action, Claims 40-41, 44, 47 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lorch, *et al.*, International Patent Publication No.: WO 02/51051 (Reference 1 of the IDS submitted May 23, 2005). Applicant respectfully traverses. As an initial matter, Claims 44, 47 and 49 have been cancelled, rendering the rejections of these claims moot. The Office Action admits that Lorch does not explicitly teach that the naming profile also includes a return to address. Applicant agrees. However, the Office Action takes the position that this difference is solely found in the non-functional descriptive material of the stored address data itself. Applicant respectfully disagrees with this proposition.

Claim 40 recites the features of “a naming profile including an addressee address ***and*** a ***return to address***, the addressee address and the return to address being one of a physical address, the first pseudo name, the second pseudo name, and a third pseudo name ... and means for displaying the first pseudo name in a return field on the mail object (emphasis added).” The present invention allows a user to register a pseudo name as a unique key to access their user profile and respective sub profiles, e.g. franking profile, naming profile, and dynamic profile.

The naming profile contains important information, such as the user's name, addressee details *and* a return to address. The present invention offers a complete mailing address solution, as the naming profile can have, to name a few, a home address, a current delivery address, an alternate delivery address, and a return to address. ¶[0040]. Also, by using a number of profiles for each pseudo name, users can choose to have mail delivered as directed by one or more profiles.

For example, presume that a user has the pseudo name of 'tracom'. Now, 'tracom's' profile may state that today all mail objects should be delivered to IBM Hursley. 'Tracom' may be in Chicago on business for the next 10 days and therefore wishes to have all mail redirected to IBM Chicago for the next 10 days. The user updates the 'send to' address field so that, for the next 10 days, all mail is to be sent to IBM Chicago. In addition, a user can change an address to another pseudo name, restrict mail delivery to certain listed names, or filter mail from certain names to be delivered to an alternate address. ¶[0053]. For example, a mail object may contain the pseudo names //N:tracom// as the addressee, and //R:Hadley// as the return address. When the mail object is received at a post office and a scanner detects the pseudo names displayed on the mail, the naming profiles associated with each of the pseudo names are accessed to determine where the mail is to be delivered to, and where the envelope should be returned to if undeliverable.

Difference is not non-functional descriptive material

Claim 40 recites a new and non-obvious functional relationship between a return to address, the system and the naming profile. Applicant respectfully asserts that Claim 40 properly defines this relationship, and that there is a difference between Claim 40 and Lorch that is sufficient to establish patentability. Applicant respectfully asserts that the Office Action

description of an element of the invention as a return to address tells nothing about the differences between the invention and Lorch, or about whether the invention was suggested by Lorch.

Applicant respectfully asserts that this rejection is based on case law antedating the 1952 Patent Act, employing a point of novelty approach. The 1952 Act legislatively revised that approach through its requirement that a claim be viewed as a whole in determining obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Applicant respectfully asserts that the return to address is functionally related to the system and the naming profile, and Lorch fails to teach, disclose or suggest the subject matter recited in Claim 40 when considered as a whole. Accordingly, independent Claim 40 is indeed directed toward statutory subject matter in compliance with 35 U.S.C. § 101.

Specifically, the return to address clearly imparts functionality to the system, as it conveys information about where to return the mail if undeliverable. The return to address alters how the system performs, as if there is a return to address in the naming profile, the system will print the return to address in the mail object, and if there is not a return to address, then the system will not print the return to address on the mail object. If the return to address in the naming profile is a pseudo name, the system will find the profile associated with that pseudo name in order to get the physical address. The system can therefore access two different profiles when routing one mail object. Applicant respectfully asserts that there is a functional interrelationship between the return to address and the system, which permit the return to address functionality to be realized.

Not only does the return to address impart functionality to the system, but also to the data. The return to address is part of the naming profile, which has, among its other functions, the function of making available important address information that is printed in a physical mail object. The system first finds the correct naming profile, and then finds the return to address in the naming profile. If the return to address is a pseudo name, then another data structure has to be accessed, i.e. that pseudo name's naming profile. Therefore, the existence of a return to address as a pseudo name will determine whether or not another data is accessed. Applicant respectfully asserts that the return to address bears a direct relation to the other data entries on the profile.

Because the return to address is functionally related to at least the system and the naming profile, the return to address distinguishes the invention from Lorch in terms of patentability, and as such, the return to address feature must be considered. For at least this reason, Applicant respectfully requests that this rejection be withdrawn.

The present invention is not obvious

On page 5, the Office Action takes the position that, even if a functional relationship between the return address and the rest of the invention existed, its inclusion would have been obvious. Applicant respectfully traverses. The Office Action confuses having a naming profile with two addresses with "substitution of the physical sender address with a pseudo address (rather than just the recipient address)." In Lorch, there is no evidence or suggestion of "a naming profile including an addressee address *and* a return to address." Lorch is directed towards allowing "a postal *recipient* to create and maintain a proxy address which is dynamically associated with the *recipient's* postal address and is more simple than the postal address." See

Abstract. “The sender of a postal mailpiece addresses the mailpiece with the simplified proxy address instead of the burdensome *recipient* postal address.” See Abstract. Lorch uses the proxy address “to obtain a *recipient* postal address from a database.” Lorch, pg. 9, ll. 4-6. While Lorch shows that a proxy address can be associated with the recipient’s postal addresses, nothing in Lorch mentions one pseudo name being associated with *both* an addressee address *and* a return to address. There is simply no evidence or suggestion in Lorch of such a configuration. The Office Action states that recipient/sender addresses share the same format and a sender address can also serve as a recipient address. Nevertheless, this argument does not address the concept of having one pseudo name associated with *two* different addresses, where one address is the addressee address and the other is the return to address. Claim 40 is patentable for at least this reason.

Further, the Office Action has not provided any evidence that it was conventional in the art to include both addresses in a naming profile. Nothing in Lorch teaches or suggests that a return to address can be a pseudo name, or that the user’s pseudo name is displayed in the return field on the mail object. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006). Applicant respectfully asserts that nothing in Lorch, teaches, suggests or discloses that a pseudo name can have different profiles, among others, a naming profile that can contain a variety of addresses, including a return to address. For at least this additional reason, Applicant maintains that Claim 40 is patentable over Lorch.

To further distinguish Applicant’s invention from Lorch, Applicant has herein amended

Claim 40 to more clearly recite the features of the invention. Specifically Claim 40 now recites the features of “a first franking profile including a list of trusted pseudo names comprising at least one trusted pseudo name, the first pseudo name corresponding to an entity to be billed for charges incurred by the at least one trusted pseudo name, the at least one trusted pseudo name being the second pseudo name; ... billing the entity corresponding to the first pseudo name for services provided to the second pseudo name.” These features are not taught or suggested by Lorch. While Lorch shows that a “database may ... provide pre-paid postage”, or “meter number information as necessary for correct posting of postage payments,” nothing in Lorch shows that a first user can authorize a second user with a second pseudo name to charge expenses to the first user account. Lorch, pg. 23, ll. 6-9. For at least this additional reason, Applicant respectfully asserts that Claim 40 is patentable over Lorch, and respectfully requests the withdrawal of this rejection.

Additional features of Claim 40 recite “means for restricting mail delivery to receive mail from a first list of names; means for filtering mail from a second list of names to be delivered to an alternate address; and means for displaying the first pseudo name in a return field on the mail object.” These features are not taught or suggested by Lorch. While Lorch shows that a mail recipient may “record an [address] expiration date,” Lorch does not even mention filtering mail. For at least this additional reason, Applicant respectfully asserts that Claim 40 is patentable over Lorch, and respectfully requests the withdrawal of this rejection.

Independent Claim 41 recites features similar to Claim 40. Specifically amended Claim 41 recites “a first franking profile including a list of trusted pseudo names comprising at least one trusted pseudo name, the first pseudo name corresponding to an entity to be billed for

charges incurred by the at least one trusted pseudo name, the at least one trusted pseudo name being the second pseudo name; ... the addressee address and the return to address being one of a physical address, the first pseudo name, the second pseudo name, and a third pseudo name; bill the entity corresponding to the first pseudo name for services provided to the second pseudo name.” As discussed above, these features are not disclosed, taught or suggested by Lorch. As such, amended Claim 41 is believed patentable and the withdrawal of the rejection of this claim is respectfully requested.

On page 7 of the Office Action, Claims 46 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lorch, *et al.*, in view of Law, U.S. Patent No.: 7,072,845 (Reference A of the PTO-892 part of paper no 20071119). Claims 46 and 50 have been cancelled, rendering the rejections to these claims moot.

For all of the above reasons, the claim objections are believed to have been overcome placing Claims 40-41 in condition for allowance, and reconsideration and allowance thereof is respectfully requested.

The Examiner is encouraged to telephone the undersigned to discuss any matter that would expedite allowance of the present application.

The Commissioner is hereby authorized to credit overpayments or charge payment of any additional fees associated with this communication to Deposit Account No. 090457.

Date: February 10, 2009

Respectfully submitted,

/Alan M. Weisberg/

Alan M. Weisberg

Reg. No.: 43,982

Attorney for Applicant

Christopher & Weisberg, P.A.

200 East Las Olas Boulevard, Suite 2040

Fort Lauderdale, Florida 33301

Customer No. 68786

Tel: (954) 828-1488

Fax: (954) 828-9122

email: ptomail@cwiplaw.com

131582